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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,512	03/19/2004	Olaf Hohenberg	512425-2103	7638

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FROMMER LAWRENCE & HAUG LLP
745 Fifth Avenue
New York, NY 10151

EXAMINER

MOORE, MARGARET G

ART UNIT PAPER NUMBER

1712

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/804,512	Applicant(s) HOHENBERG ET AL.	
	Examiner Margaret G. Moore	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 16, 18 to 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 8, 10, 13 to 16, 18, 19, 24 to 27 is/are rejected.
- 7) ☒ Claim(s) 9, 11, 12, 20 to 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicants' amendment has overcome the rejections under 35 USC 112.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 to 5, 10, 13, 15, 16, 18, 19 and 24 to 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Boudjouk et al.

This rejection is maintained from the previous office action. Since the rejection rationale is the same as noted in the previous office action, it will not be repeated.

Applicants' traversal of this rejection is not persuasive. They note that the amended claims no longer encompass making aminofunctional alkoxy polysiloxanes. Applicants' attention, however, is drawn to the bottom of column 6, lines 64 and on, in which Boudjouk et al. teach that the aminoalcohol can contain a mixture of aminoalcohol and "plain" alcohol, including ethanol, within the breadth of claim 13. Note that the claims do not exclude the presence of an additional alcohol such as aminoalcohol. As such Boudjouk et al. meet the claimed process.

Applicants additionally argue that it is not clear from the teachings in Boudjouk et al. that patentees adequately describe or enable anything beyond rhodium based catalysts. The Examiner disagrees. A reference must be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-

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preferred embodiments. Patentees specifically detail particular catalysts that are useful in the disclosed process and, outside of applicants' speculation, there is nothing to indicate that the catalysts taught by Boudjouk et al. would not be useful. Note too that when a species is clearly named, the species claim is anticipated no matter how many other species are additionally named. Patentees need not teach the broadly claimed main group III or transition group III catalysts to meet the claims. The specific teaching of one species is sufficient to anticipate instant claim 1.

As an aside, the Examiner notes that arguments drawn to any differences in process conditions or catalyst selection carry no weight on the patentability of the product claims 25 to 27.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boudjouk et al.

This rejection is maintained from the previous office action. Since the rejection rationale is the same as noted in the previous office action, it will not be repeated.

Applicants note that only a result effective variable can be optimized. The ratio of SiH groups to alcohol groups, however, does not appear to be a result effective variable. Rather this is optimization of the process conditions set forth in Boudjouk et al. This rejection is maintained.

6. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boudjouk et al. as applied to claims 1 to 5 above, and further in view of Blackwell et al. or WO 01/74938 (as interpreted by the English language equivalent Deforth et al.).

This rejection is maintained from the previous office action. Since the rejection rationale is the same as noted in the previous office action, it will not be repeated.

The Examiner disagrees with applicants' "obvious to try" rationale or the argument that the processes in these references are different such that one would not have motivation to use the catalyst in one process in place of the other. As noted in the previous office action, each reference teaches the dehydrogenative coupling between an Si atom and an alcohol OH group. While applicants repeatedly note that only Rh

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based catalysts are exemplified the Examiner believes it is important to note that the claims in Boudjouk et al. are inclusive of any dehydrogenative coupling catalysts, such as those found in Blackwell et al. and Deforth et al. As such this rejection is maintained.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable Boudjouk et al. as applied to claims 1 to 5 above, and further in view of Beattie et al.

This rejection is maintained from the previous office action. Since the rejection rationale is the same as noted in the previous office action, it will not be repeated.

Note the examiner comments in paragraph 6, supra, as they presently apply.

8. Claims 9, 11, 12 and 20 - 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. With regard to applicants' request for interview, the Examiner is unsure if it is their intent to schedule an interview in lieu of this office action since it is unclear if the above rejections, which are the same as those made in the previous office action, are considered to be an issue remaining as an impediment to allowance. However, if it is applicants' intent to schedule an interview, they are requested to submit the PTOL-413A form referenced in MPEP 713.01, III.

Furthermore, in response to applicants request that the teachings of MPEP 707.07(j) be applied, the Examiner notes that she has, as she did in the previous office action, indicated allowable subject matter.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

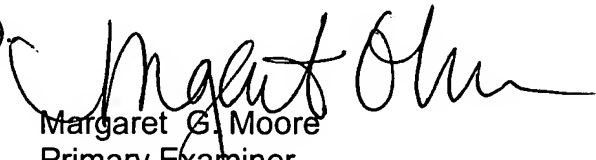
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Margaret G. Moore
Primary Examiner
Art. Unit 1712

mgm
12/17/05